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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,139	10/10/2001	Volker Schellenberger	23623-7060	8883

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EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/975,139

Applicant(s)

SCHELLENBERGER ET AL.

Examiner

Channing S Mahatan

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-6, 11, 14-23, 25-29 and 31.Claim(s) withdrawn from consideration: 7.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

C. Ma / f
September 13, 2004

Marianne P. Allen
MARIANNE P. ALLEN
PRIMARY EXAMINER

9/14/04
AU 1631

Continuation of 10. Other: The amendment in the response filed 11 August 2004 will not be entered for the following reasons pertaining to claim 11: 1) it is unclear if the produced substitution scheme is intended to be applied in the creation of the library of DNA sequences (112 2nd Paragraph) or if additional steps are intended for said library (112 2nd Paragraph Missing Essential Steps). With respect to Applicants arguments that Marr et al. (U.S. Patent 5,701,256) does not teach the transfer of information to a DNA library for construction, the Examiner disagrees. Regarding such limitation the instant claim(s) state "creating a library of DNA sequences incorporating changes in the DNA sequence that produce the recommended substitution" (i.e. claim 1), wherein said library of DNA sequences is broadly interpreted to encompass in silico results of DNA sequences obtained via the searching. For instance, after the disclosed methods are applied to search libraries (noted by Applicants in the response filed 11 August 2004, on page 8, lines 15-16) the search results are obtained (de facto in silico DNA library) which has the recommended substitutions. If Applicants regard the created library of DNA sequences to be a physical one, the claims are not limited in such manner. It should be noted Applicants assumption that the rejection of claim 24 pertains to claim 25 since claim 24 has been cancelled is correct, wherein claim 24 was a typographical error. Thus, the rejections and objections to claims 1-6, 11, 14-23, 25-29, and 31 are maintained for reasons of record since the amendment filed 11 August 2004 has not been entered..